

Attorney Docket No. AUS920030842US1
Serial No. 10/777,717

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II. REMARKS

A. Summary of the Response

Claims 1-12; 14-24; and 26-41 were rejected

Claims 2, 13, 25, and 35 have been canceled

Claims 1, 3, 4, 6-12, 14, 15, 26, 28, 29, and 37 are amended

Claims 1, 3-12; 14-24; 26-34 and 36-41 remain pending

B. Detailed Response

1. Claim Rejections –

35 USC § 101

Claims 26 to 36

The examiner rejected claims 26-36 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Response: Independent claim 26 has been amended to clarify that Applicants' embodiment is a computer readable medium having a computer program for causing a computer to create a secure shopping token containing the terms of a contract between a buyer and a seller. Applicants respectfully submit that independent claim is in a form for allowance over the rejection under 35 U.S.C. § 101. Claims 27 to 36 are dependent on claim 26 and are in a form for allowance over this rejection for the same reason as claim 26. Other amendments were also made to these claims as discussed below.

2. Claim Rejections –

35 U.S.C. § 112

(All Pending Claims)

The examiner rejected claims 1-12, 14-24, and 26-41 under 35 U.S.C. § 112 as failing to comply with the written description requirement.

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Response: Independent claims 1, 14, 26 and 37 have been amended to more clearly describe the Applicants embodiments and to remove the negative limitations mentioned by the Examiner.

For example, the Examiner objected to the negative element in all of the independent claims that stated:

wherein the shopping token is created without linking a compilation of business rules residing on an administrator organization electronic commerce system to a terms and conditions set...

All of the amended claims have been amended to contain an equivalent statement that the shopping token is "read only" (independent claims 1, 14 and 26) or that the shopping token may not be modified (independent claim 37 and other dependent claims) see [0014; 0036, 0039].

According to the specification [at least 0026], "the term 'read only' shall mean a document that cannot be modified by a buyer or a seller." Additionally, the term "shopping token" is further defined to mean [0028]:

an XML document that contains the agreement between the buyer and the seller in which the buyer and seller can initially modify the terms within the document, and that becomes a read only document when both the buyer and the seller have added their digital signatures to the document.

The Examiner also objected to the negative limitation: "it is not necessary to check in/check out the shopping token to a server..." That negative limitation has also been amended for all of the independent claims. The claims have been amended to include an express reference to the creation of the XML file on a computer that is accessible to both the buyer and the seller.

Support for this amendment is found in at least [at least 0028; Fig 3 & 4]

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3. **Claim Rejections –**

35 USC § 103

(Claims 1-9, 14-21, 26-33, and 37-38)

The examiner rejected claims 1-9, 14-21, 26-33, and 37-38 under 35 U.S.C. 103(a) as being unpatentable over Albazz et al. (US 20020042872, hereinafter, "Albazz") in view of Conklin et al. (US 6141653, hereinafter, "Conklin").

Response: Albazz alone or in combination with Conklin do not teach or suggest all of the elements of the amended independent claims 1, 14, 26 and 37. According to MPEP 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The claims have been amended to more clearly describe the Applicants' embodiments. Support in the specification for these amendments are discussed above. Independent claims 1, 14, 26 and 37 have been amended (among others) to provide as follows:

1. (Presently amended) A method for electronically creating a contract between a buyer and a seller in an online transaction by means of a read only shopping token that contains a plurality of agreement terms; wherein the shopping token is created in a single file at a single computer that is accessible by both the buyer and the seller, the method comprising:

creating an XML file at a single computer that is accessible by both the buyer and the seller; and

responsive to the addition of a buyer digital signature and a seller digital signature to the XML file, saving the XML file as the read only shopping token, wherein data in the shopping token cannot be cut and pasted from the shopping token, the shopping token can be stored on a

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buyer computer, a seller computer, or a third party computer, and the shopping token is indexed so that it can be distinguished from another shopping token.

14. (Presently amended) A program product for electronically creating a contract between a buyer and a seller in an online transaction by means of a shopping token that contains a plurality of agreement terms comprising:

a computer-usable medium;

wherein the computer usable medium comprises instructions for a computer to perform steps comprising:

instructions for creating an XML file on a computer that is accessible to both the buyer and the seller;

instructions for recording the preliminary contract terms between the buyer and the seller into the XML file;

instructions for adding a plurality of contract terms to the XML file, wherein the preliminary contract terms may be supplemented, modified or deleted by the buyer and the seller prior to a final contract between the buyer and the seller;

responsive to the addition of a buyer digital signature and a seller digital signature to the XML file, instructions for saving the XML file as a read only shopping token;

instructions for creating the shopping token in a single file at a single computer ; and

wherein the shopping token contains the final contract terms between the buyer and the seller.

26. (Presently amended) A shopping token recorded on a computer readable medium that contains a plurality of agreement terms between a buyer and a seller created by computer implemented steps comprising:

a computer readable storage medium;

a computer program stored in the storage medium, wherein the storage medium, so configured by the computer program, causes a computer to perform the steps of:

creating a computer readable XML file that is accessible by both a buyer and a seller in an on-line transaction;

receiving a digital signature in response to an input from the buyer indicating the consent of the buyer to the contract terms;

receiving a different digital signature in response to an input from the seller indicating the consent of the seller to the contract terms;

saving each digital signature to the XML file; and

saving the XML file as a read only shopping token;

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wherein responsive to creation of the shopping token, a contract is electronically created between a buyer and a seller in the online transaction; and

wherein the shopping token will be invalidated upon any subsequent change in the contract terms.

37. (Presently amended) An apparatus for creating a shopping token that contains a plurality of agreement terms between a buyer and a seller comprising:

means for creating an XML file on a computer that is accessible by the buyer and the seller;

means for adding a seller's personal information to the XML file; means for adding a buyer's personal information to the XML

file;

means for adding information regarding a good to the XML file; means for adding a plurality of terms to the XML file;

means for presenting the terms to the buyer and the seller;

means for determining whether the buyer and the seller agree with the terms; and

responsive to the determination that the buyer and seller agree with the terms, means for adding a buyer digital signature and a seller digital signature to the XML file to create a read only shopping token;

responsive to the determination that the buyer and seller do not agree with the terms, means for accepting a modification to the XML file;

wherein the shopping token is created after the buyer is aware of the delivery date for the good;

wherein the shopping token may be configured so that the shopping token is not modifiable by the buyer or the seller or any third party;

wherein the shopping token is stored on a third party computer;

wherein the shopping token is created in a single file at a single computer;

wherein data in the shopping token cannot be cut and pasted from the shopping token, the shopping token can be stored on a buyer computer, a seller computer, or a third party computer, and the shopping token is indexed so that it can be distinguished from another shopping token; and

wherein the shopping token is invalidated upon any subsequent change in the contract terms between the buyer and the seller.

The Albazz application is under common ownership (i.e. International Business Machines Corporation) with the present application. Albazz is a *dynamic* system for generating a contract

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between a buyer and a seller in a business to business setting. Albazz contemplates that either the buyer or the seller will have a "Business Rules Book (BRB) from which specific rules may be selected for inclusion in the contract [0015]. Albazz anticipates a continuing business relationship between the parties wherein a dynamic list of specific goods or services are ordered or sold over time. The list of goods or services is "filtered" to limit the choices to certain specific items, but *the product list is "dynamic" and may change over time* [0080] "*whenever the seller decides* [0083] While the Albazz electronic contract may be "locked" [0086] it is not "read only" or static. For example, "Changes to the contents of a Dynamic Element, for example where updates are made by the seller to the master product catalog contents..., do not require the buyer's approval ... and such changes are contemplated by the contract." [0088] Rather, "Dynamic Elements ... are maintained fully up to date by virtue of the seller's background maintenance and updating of catalogs and other product information...." [0092]. The presence of such dynamic product lists and other "Dynamic Elements" in the agreement terms would not be possible in the Applicant's "read only" embodiments. Albazz provides for the dynamic adjustment of the electronic contract with changing circumstances over time [0049]. The Applicants *prevent* such changes.

Conklin does not cure the deficiencies of Albazz. Conklin is an administered "community" of buyers and sellers with common interests. [see at least Abstract; Fig. 3]. Conklin maintains internal databases operated by the system provider's internet site. It is a complex system of multiple buyers and multiple sellers brought together only through a common interest. [see for example Fig. 27]. Conklin does not create a single read only "shopping token" that represents an electronic contract between a given buyer and a given seller. Conklin does not teach the access of both a buyer and a seller to a common file. Like Albazz, Conklin is a rule

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driven system with multiple files and databases. Conklin, alone or in combination with Albazz do not teach or suggest a computer system that creates a read only shopping token through a computer system that is accessible by both a buyer and a seller.

4. Claim Rejections –

35 USC § 103

(Claims 10-12, 22-24, 34-36, and 39-41)

The examiner rejected claims 10-12, 22-24, 34-36, and 39-41 under 35 U.S.C. 103(a) as being unpatentable over Albazz in view of Conklin as applied to claims 1-9, 14-21, 26-33, and 37-38, and in further view of Moss et al. (US 20050169014, hereinafter, “Moss”).

Response: All of these claims are dependent upon allowable claims 1, 14, 26 and 37 discussed above. They contain all of the elements of those claims and are allowable for the same reasons

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III. CONCLUSION

Applicant respectfully submits that claims presented are all in a condition for allowance.

In the event that the Examiner believes that additional rejections are in order, the Applicants respectfully request that the above amendments be entered in order to reduce the issues on appeal. If the Examiner has any questions or concerns regarding the present claims, the undersigned requests the scheduling of a telephone interview to discuss this case in greater depth. The Applicant's counsel may be reached at the telephone number given below

Respectfully submitted,

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